

REMARKS**I. Status of claims**

By this Amendment, Applicants amend the Specification and Figs. 9, 16 and 22 in the Drawings. Applicants also amend claims 1, 13, 20-55, 57-86. Claims 1-86 remain pending in this application.

In the Office Action of July 6, 2004,¹ the drawings were objected to for alleged errors, the Specification was objected to for minor informalities; and claims 22, 23, 25-35, 37-55, 57-68 and 71-86 were objected to for informalities. In addition, the claims were rejected as follows:

- (1) Claims 57, 67, and 71 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite;
- (2) Claims 1-6 and 36-41 rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application Publication No. 2002/0035611 ("*Dooley*");
- (3) Claims 24-27, 56-59 and 61-69 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application Publication No. 2003/0061202 ("*Coleman*");
- (4) Claims 21-23 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Application Publication No. 2002/0024528 ("*Lambertsen*") in view of *Coleman*;
- (5) Claims 28-35, 70-79 and 81-86 were rejected under 35 U.S.C. § 103(a) as unpatentable over *Coleman* in view of *Lambertsen*;
- (6) Claims 13, 42-44 and 47-51 were rejected under 35 U.S.C. § 103(a) as unpatentable over *Dooley* in view of *Coleman*;
- (7) Claims 45 and 46 were rejected under 35 U.S.C. § 103(a) as unpatentable over *Dooley* in view of *Coleman* and *Lambertsen*;
- (8) Claims 17-19 and 52-54 were rejected under 35 U.S.C. § 103(a) as unpatentable over *Dooley* in view of *Lambertsen*;

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

- (9) Claims 20 and 55 were rejected under 35 U.S.C. § 103(a) as unpatentable over *Dooley* in view of *Lambertsen* and *Coleman*;
- (10) Claim 60 was rejected under 35 U.S.C. § 103(a) as unpatentable over *Coleman* in view of *Dooley*; and
- (11) Claim 80 was rejected under 35 U.S.C. § 103(a) as unpatentable over *Coleman* in view of *Lambertsen* in further view of European Patent Application Publication No. 0226959A2 (“*Horikita*”) and further in view of U.S. Patent No. 6,707,929 to *Marapane et al.* (“*Marapane*”).

Applicants address the objections and rejections below.

I. Objection to the Drawings

The Examiner averred that item 540 of Fig. 9 should be labeled “AI engine” (Office Action “OA” at 3). The Examiner also noted that both “YES” and “NO” are selected in item U.170 in Fig. 22, and that Fig. 16 does not depict the purchase history mentioned on page 25 of the Specification (OA at 3).

Applicants submit herewith three (3) sheets of replacement drawings (containing Figs. 9, 16 and 22) to address the Examiner’s objection. In the replacement drawings, item 540 of Fig. 9 is labeled “AI ENGINE;” item U.170 of Fig. 22 is amended so that only “YES” is shown as selected; and user profile 714 of Fig. 16 is amended so that it depicts “purchase history.” Applicants submit that no new matter has been added. Applicants deem the Examiner’s objection to the drawings overcome by the submitted replacement drawing sheets and thus request withdrawal of the objection.

Applicants request that the replacement drawings be made of official record in this patent application. If the drawings for any reason are not in full compliance with the pertinent statutes and regulations, please so advise the undersigned.

II. Objection to the Specification

The Examiner objected to the specification for informalities (OA at 3). Specifically, the Examiner suggested changing “afore-mentioned” to “aforementioned” on page 18, ¶ 65; changing “included” to “include” on page 45, ¶ 141; and changing “urban dweller suburban” to “urban dweller, suburban” on page 54, ¶ 158 (OA at 3-4). Applicants amend pages 18, 45 and 54 of the Specification in accordance with the Examiner’s suggestions and, thus, deem the objection to those portions of the Specification overcome.

The Examiner also stated (OA at 3) that “(S.300) on page 40, [0130] would read better as (S.305).” Applicants recognize that paragraph 130 on page 40 contains a minor error, but disagree with the Examiner’s suggestion. Applicants amend the phrase “receiving an order from the subject (S.300)” in paragraph 130 on page 40 to read “receiving an order from the subject (S.310).” Item S.300 should not be changed to S.305, as suggested by the Examiner. Applicants deem the objection to paragraph 130 on page 40 of the Specification overcome.

The Examiner further stated that the discussion of definitions starting on page 42 would be better placed at the beginning of the specification (OA at 3-4). Applicants disagree with the Examiner and traverse the objection. The discussion of terminology starting on page 42 follows the discussion of cross-referenced applications and provides global definitions. The global definitions would not be better placed at the beginning of the Specification, and the Examiner has not demonstrated the contrary. Applicants therefore request withdrawal of the objection to the placement of the global definitions.

In addition, the Examiner asserted that “Examples of services forms of beauty products” on page 50, ¶ 150, would read better as “Examples of beauty services” (OA at 4). Applicants amend the phrase “Examples of services forms of beauty products” on page 50, ¶ 150, to read

“Examples of service forms of beauty products.” Applicants submit that this language is appropriate, as the Specification at page 49, ¶ 149, indicates that the term “product” includes services. Applicants therefore request withdrawal of the objection to page 50, ¶ 150.

The Examiner objected to claims 7-12 and 14-16 under 37 C.F.R § 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative and also cannot depend from another multiple dependent claim. Applicants disagree with this objection. Contrary to the Examiner’s position, claims 7-12 and 14-16 are proper. None of claims 7-12 and 14-16 is a multiple dependent claim. Further, claim 3, upon which claims 7 and 12 depend, is a proper multiple dependent claim that refers to claims 1 and 2 in the alternative. Applicants therefore request withdrawal of the objection to claims 7-12 and 14-16 under 37 C.F.R § 1.75(c). For the foregoing reasons, Applicants request withdrawal of the objection to the Specification.

Applicants acknowledge the Examiner’s request for cooperation in correcting any errors in the Specification. Applicants have corrected minor errors and will correct any errors of which they may become aware during prosecution of this application.

III. Objection to claims 22, 23, 25-35, 37-55, 57-68 and 71-86

Claims 22, 23, 25-35, 37-55, 57-68 and 71-86 were objected to for informalities. The originally-filed claims were numbered 1-20, 22-87 instead of 1-86 and, consequently, as the Examiner noted, dependent claims 22, 23, 25-35, 37-55, 57-68 and 71-86 did not refer to the proper base claims. Applicants have amended claims 22, 23, 25-35, 37-55, 57-68 and 71-86 to resolve those dependency issues. Applicants deem the objection overcome and therefore request its timely withdrawal.

IV. Section 112, ¶ 2, Rejection of claims 55, 67 and 71

With regard to claim 55, the Office Action alleged that “the term ‘is directly not maintained’ is a relative term which renders the claim indefinite” (OA at 7). The Office Action further alleged that “the specification does not provide a standard for ascertaining the meaning of the phrase “suitability of combining information is directly not maintained”, and one of ordinary skill in the art would not reasonably apprise of the scope of the invention (OA at 7).

As currently presented, claim 55 depends from claim 52 and recites in part:

. . . wherein information about suitability is information on less than a universe of all combinations of the plurality of beauty products, and wherein when an individual selects a combination of beauty products for which suitability of combining information is not directly maintained by the data structure, the artificial intelligence engine is configured to identify a product likely to be complementary to the user-selected combination.

Applicants submit that claim 55 is fully compliant with 35 U.S.C. § 112, 2nd paragraph. As M.P.E.P. 2173.02 makes clear, “[t]he essential inquiry pertaining to [the]...requirement [of definiteness] is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity.” The subject matter defined by claim 55, as amended, is set forth with a reasonable degree of clarity and particularity and a skilled artisan would be apprised of the scope of claim 55 from the claim language itself and the supporting disclosure (see Specification, e.g., pages 17-18, ¶ 63; page 19, ¶¶ 67, 68; and pages 22-23, ¶ 78).² Further, Applicants remind the Examiner that “[s]ome latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the

² In referring to the Specification, Applicants do not intend to limit the scope of the claims to the exemplary embodiments shown in the drawings and described in the specification. Rather, Applicants expressly affirm their entitlement to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

examiner might desire.” M.P.E.P § 2173.02 (8th ed. 2001). Claim 55 is fully compliant with 35 U.S.C. § 112, 2nd paragraph, and thus the § 112 rejection of that claim should be withdrawn.

With regard to claim 67, the Office Action avers that the term “product interest” renders the claim indefinite. Although disagreeing with the rejection, Applicants have amended claim 67 to remove “product interest” from the claim. Applicants therefore deem the § 112 rejection of claim 67 overcome and request its timely withdrawal.

With regard to claim 71, the Office Action states that the term “subject” renders the claim indefinite. According to the Examiner, “the specification does not provide a standard for ascertaining whether the term ‘subject’ is referring to the user, customer, consumer, or a super-category . . . ” (OA at 7). Applicants traverse this rejection. The subject matter defined by claim 71 is set forth with a reasonable degree of clarity and particularity. A skilled artisan would be reasonably apprised of the scope of the term “subject” from the claim language itself and the supporting disclosure, and Applicants should not be required to limit that claim to a user, customer or consumer. The Examiner provides no reasoning or evidence as to why the term *user*, *customer* or *consumer* would be more definite than the term *subject*. Further, the term *subject* appears in several other claims (e.g., claim 70) that were not rejected as being indefinite because of that term. Applicants therefore request withdrawal of the § 112 rejection of claim 71.

V. Rejection of claims 1-6 and 36-41 under 35 U.S.C. § 102(e)

Applicants traverse the rejection of claims 1-6 and 36-41 under 35 U.S.C. § 102(e) because *Dooley* does not anticipate those claims. In order to properly anticipate Applicants’ claimed invention under 35 U.S.C. § 102, each and every element of the claim at issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Further, “[t]he identical invention must be shown in as complete detail as is contained in the . . .

claim[s].” See M.P.E.P. § 2131. Finally, “[t]he elements must be arranged as required by the claim.” *Id.*

Claim 1, as currently presented, recites a combination including:

accessing a data structure containing information reflecting relationships between categories of user-specific information and beauty advice, the information reflecting relationships derived from at least one of consumer preferences and expert advice; [and]

identifying, using the artificial intelligence engine, beauty advice determined by the artificial intelligence engine to be related to the user-specific information.

Dooley does not disclose the “accessing” recited in claim 1. *Dooley* is directed to an Internet-based information network (Abstract). In particular, *Dooley* describes a network of linked websites related to a particular field that increases the network owner’s web presence (and search engine ranking) and reduces the need for conventional advertising. The Office Action notes *Dooley*’s disclosure of a “lexicon” of categorized domain names that can include medical professionals (e.g., beauty-consultants.net) and can be deployed as websites (page 3, ¶¶ 31-32; pages 7-8, ¶ 70). The Office Action also notes *Dooley*’s disclosure that the information network includes system websites and entry websites (page 4, ¶ 39) and that placement within search engine results may be affected by various web design elements (page 5-6, ¶ 56). These disclosures do not support the allegation that *Dooley* discloses the claimed “accessing.” A lexicon of categorized domain names is not consistent with a data structure containing information reflecting relationships between categories of user-specific information and beauty advice. In addition, *Dooley* does not disclose accessing the lexicon. Further, neither networking system and entry websites nor affecting search engine results using design elements constitutes the claimed “accessing.” The Office Action alleged (OA at 8) that *Dooley* anticipates the claimed “user-specific information” because it discloses obtaining identifying and registration

information (page 6, ¶ 57). Even using that interpretation of user-specific information, *Dooley* does not teach or suggest the “accessing” recited in claim 1. That is, *Dooley* does not disclose accessing a data structure containing information reflecting relationships between categories of identifying/registration information and beauty advice. Moreover, *Dooley* does not disclose beauty advice. Although *Dooley* discloses website content, it does not disclose that such content includes beauty advice. Even if *Dooley*’s websites were to include beauty advice, *Dooley* does not disclose accessing a data structure containing information reflecting relationships between categories of user-specific information and those websites.

Dooley also fails to disclose the “identifying” recited in claim 1. The Office Action notes *Dooley*’s disclosure of creating a “lexicon” of categorized domain names that can include medical professionals (e.g., beauty-consultants.net) and that can be deployed as websites (page 3, ¶¶ 31-32; pages 7-8, ¶ 70). The Office Action also notes *Dooley*’s disclosure of obtaining identifying/registration information from a user (page 6, ¶ 57). Contrary to the Examiner’s position, neither mining available domain names nor creating a lexicon of categorized domain names is consistent with identifying, using an artificial intelligence engine, beauty advice determined to be related to the user-specific information, as claimed. In addition, neither obtaining search results nor obtaining identifying/registration information constitutes the claimed “identifying.”

Further, to the extent the Examiner is alleging that *Dooley*’s websites include beauty advice, such an allegation is not properly supported. *Dooley* does not disclose that websites associated with the domain names include “beauty advice.” In fact, *Dooley* discloses that the domain names (e.g., beauty-consultants.net) may be deployed as websites with minimal content or even as active domain names without associated websites (page 4, ¶ 40). The fact that a

domain name in *Dooley*'s information network might be "beauty-consultants.net" does not in and of itself evidence that the site provides "beauty advice." According to *Dooley*, such a site may serve only to increase a network owner's web presence or search engine rating. Even if the websites were construed as including beauty advice, *Dooley* does not disclose identifying, using an artificial intelligence engine, such beauty advice determined by the artificial intelligence engine to be related to user-specific information. Indeed, *Dooley* merely describes a network of websites related to a field that increases the network owner's web presence.

In addition, although *Dooley* mentions "artificial intelligence software," it merely mentions that such software can customize a user's session and assist routing the user through the network of websites. For at least the foregoing reasons, *Dooley* does not teach the claimed "accessing" or "identifying." Because *Dooley* does not disclose each and every feature of claim 1, as a matter of law, it cannot anticipate claim 1. The § 102 rejection of claim 1 should therefore be withdrawn.

Independent claim 36 recites a combination including:

a data structure containing information reflecting relationships between categories of user-specific information and beauty advice, the information reflecting relationships derived from at least one of consumer preferences and expert advice; [and]

an artificial intelligence engine, configured to receive and process the information reflecting relationships and user-specific information, to thereby identify beauty advice determined by the artificial intelligence engine to be related to the user-specific information.

Although claim 36 is of different scope than claim 1, *Dooley* does not anticipate claim 36 for reasons similar to those presented above in connection with claim 1. In particular, a lexicon of categorized domain names is not consistent with a data structure containing information reflecting relationships between categories of user-specific information and beauty advice.

Further, *Dooley* does not disclose beauty advice. A listing of domain names does not constitute beauty advice, and *Dooley* does not disclose that websites associated with the domain names (if any) contain beauty advice. In addition, *Dooley*'s lexicon does not contain information pertaining to user-specific information as that user-specific information is interpreted by the Examiner. *Dooley* does not disclose that the lexicon (or any other element) contains information reflecting relationships between user-specific information and beauty advice. Because *Dooley* does not teach or suggest each and every feature of claim 36, as a matter of law, it cannot anticipate claim 36.

Claims 2-6 and 37-41 depend from claims 1 and 36 respectively. *Dooley* does not anticipate claims 2-6 and 37-41 for at least reasons similar to those presented above in connection with claims 1 and 36. Because *Dooley* fails to anticipate claims 1-6 and 36-41, the rejection under 35 U.S.C. § 102(e) should be withdrawn. Applicants thus request withdrawal of the § 102 rejection of claims 1-6 and 36-41 and the timely allowance of those claims.

VI. Rejection of claims 24-27, 56-59 and 61-69 under 35 U.S.C. § 102(e)

Applicants traverse the rejection of claims 24-27, 56-59 and 61-69 under 35 U.S.C. § 102(e) because *Coleman* does not anticipate those claims.

With regard to independent claim 24, *Coleman* does not teach or suggest at least the following features:

accessing through the artificial intelligence search engine
information about relationships between at least some of the
plurality of products; [and]

identifying, by the artificial intelligence engine, at least one
recommended product complementary to the at least one user-
specified product using at least the information about product
relationships.

Coleman is directed to using “a fuzzy logic engine (FLE) for an interactive product selector” (Abstract). Specifically, *Coleman* describes a FLE that can “evaluate . . . user requirements against available products or services to generate product or service recommendations most closely matching the user requirements” (page 6; ¶ 57). In *Coleman*’s system, a user selects a category of goods or services (FIG. 8; page 9, ¶ 81). A product criteria is then generated in response to the selection (FIG. 8; page 9, ¶ 82). The user specifies options for the criteria, and a product set is assembled by sorting a preprocessed set of products according to the user-specified options (FIGS. 8, 9; pages 10-11).

Coleman does not disclose “information about relationships between at least some of . . . [a] plurality of products,” let alone accessing such information through an artificial intelligence search engine, as claimed. The Examiner notes *Coleman*’s disclosure of identifying products by measuring user requirements and changes in those requirements (page 1, ¶ 10). This disclosure does not constitute the claimed “accessing.” To the extent *Coleman* could be construed as disclosing information about relationships at all, it merely mentions matching user preferences to products. Relationships between user preferences/selections and products are not the same as relationships between some of a plurality of products themselves. Further, *Coleman* does not disclose accessing information about relationships between products through an artificial intelligence search engine. Although *Coleman* mentions a fuzzy logic unit, that unit does not access information about relationships between products. Instead, *Coleman*’s FLE merely assembles a product set by sorting a preprocessed set of products according to user requirements.

Coleman also lacks disclosure of “identifying, using the artificial intelligence engine, at least one recommended product complementary to the at least one user-specified product using at least the information about product relationships,” as claimed. *Coleman* merely describes

assembling a product set that most closely matches user-inputted requirements. Assembling a product set based on user requirements is not the same as identifying a product that is complementary to a user-specified product using at least information about product relationships. To the extent *Coleman*'s system identifies products, it does so using user-inputted requirements and criteria, not using information about relationships between products.

The Office Action notes *Coleman*'s disclosure that a user can select a number of products from the assembled set for "a side-by-side comparison" (page 6, ¶ 52). This disclosure does not anticipate the claimed "identifying." Allowing a user to compare products is not consistent with identifying at least one recommended product complementary to at least one user-specified product, as claimed. Indeed, *Coleman* does not disclose the claimed "identifying."

For at least the foregoing reasons, *Coleman* does not teach the claimed "accessing" or "identifying." Because *Coleman* does not disclose each and every feature of claim 24, as a matter of law, it cannot anticipate claim 24. The § 102 rejection of claim 24 should therefore be withdrawn.

With regard to independent claim 56, *Coleman* fails to teach or suggest at least the following features:

at least one location for storing information about suitability of using at least one of the plurality of products with at least one other of the plurality of products . . . and

an artificial intelligence engine configured to process information reflective of the at least one user-selected product, at least some of the characterizing information, at least some of the suitability information, and at least some of the personal information, and to identify therefrom at least one product complementary to the at least one user-selected product.

Coleman does not disclose "information about suitability of using at least one of the plurality of products with at least one other of the plurality of products," let alone "at least one

location for storing” such information, as claimed. The Office Action notes *Coleman*’s disclosure of a “server 104” (page 2, ¶ 28). *Coleman*’s server, however, does not store information about suitability as claimed.

Coleman also fails to disclose the “artificial intelligence engine” recited in claim 56. Although *Coleman* mentions fuzzy logic, it does not disclose “an artificial intelligence engine configured to process information reflective of . . . at least some of the suitability information . . . and to identify therefrom at least one product complementary to the at least one user-selected product,” as claimed. Instead, *Coleman*’s FLE merely evaluates “user requirements against available products or services to generate product or service recommendations most closely matching the user requirements.” Matching user requirements to available products is not the same as identifying a product that is complementary to a user-selected product by processing information about suitability of using at least one product with at least one other product. In addition, the disclosure of allowing a user to compare products does not teach or suggest the claimed “artificial intelligence engine.” Because *Coleman* does not teach each and every feature of claim 56 it cannot anticipate that claim.

Independent claim 69 recites, *inter alia*:

accessing through the artificial intelligence search engine
information about relationships between at least some of the
plurality of products; [and]

identifying, by the artificial intelligence engine, a second
recommended product complementary to the first product based on
at least the information about relationships.

Although claim 69 is of different scope than claim 24, *Coleman* fails to disclose the “accessing” and “identifying” recited in claim 69 for at least reasons similar to those presented above in connection with claim 24. For example, as explained above, *Coleman* discloses identifying products based on user-inputted requirements and criteria, not based on information about

relationships between products. Because *Coleman* does not teach each and every feature of claim 69 it cannot anticipate that claim.

Each of claims 25-27, 57-59 and 61-68 depends from claim 24 or 56. *Coleman* does not anticipate claims 25-27, 57-59 and 61-68 for at least reasons similar to those presented above in connection with claims 24 and 56. Because *Coleman* fails to anticipate claims 24-27, 56-59 and 61-69, the rejection under 35 U.S.C. § 102(e) should be withdrawn. Applicants thus request withdrawal of the § 102 rejection of claims 24-27, 56-59 and 61-69 and the timely allowance of those claims.

VII. Rejection of claims 21-23 under 35 U.S.C. § 103(a)

Applicants traverse the rejection of claims 21-23 under 35 U.S.C. § 103(a) because a case for *prima facie* obviousness has not been established. To establish *prima facie* obviousness under 35 U.S.C. § 103(a), three requirements must be met. First, the applied references, taken alone or in combination, must teach or suggest each and every element recited in the claims. *See* M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the reference(s) or in the knowledge generally available to one of ordinary skill in the art, to combine or modify the reference(s) in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” M.P.E.P. § 2143 (8th ed. 2001).

Independent claim 21, as currently presented, recites a combination including:

maintaining information about suitability of use of at least some of the plurality of beauty products with other of the plurality of beauty products . . . [and]

processing, using the artificial intelligence engine, information characterizing the at least two selected beauty products and suitability of use information to thereby identify at least one

additional product, complementary to a combination of the at least two selected products.

As affirmed by the Examiner, *Lambertsen* fails to disclose “processing, using the artificial intelligence engine . . . ” as recited in claim 21.

Additionally, *Lambertsen* fails to teach or suggest at least “maintaining information about suitability,” as claimed. The Office Action notes *Lambertsen*’s disclosure of a product catalog and palette database (page 1, ¶ 8). According to *Lambertsen*, the product catalog “includes a variety of beauty products” and a palette refers to a “complete makeover, consisting of a collection of beauty products, which can ‘applied’ instantly to an image on the computer screen, together with . . . instructions implementing the manner, location, and form in which they are to be applied” (page 1, ¶ 8). Contrary to the Examiner’s position, a catalog of a variety of beauty products does not teach or suggest information about suitability of use of at least some of the plurality of beauty products with other of the plurality of beauty products. Further, a collection of beauty products that create a makeover does not teach or suggest information about suitability of use of at least some beauty products with other beauty products. Although *Lambertsen*’s palettes include products that may be suitable for use together, *Lambertsen* does not disclose maintaining information about the suitability of using products. *Lambertsen* merely discloses that the palettes are pre-configured or created by a user from a list of available products (page 3, ¶ 29). It does not disclose, for example, that the palettes are created based on information about the suitability of using products. For at least these reasons, *Lambertsen* does not teach or suggest “maintaining information about suitability,” as claimed.

Coleman does not cure *Lambertsen*’s deficiencies. *Coleman* does not disclose “maintaining information about suitability of use of at least some of the plurality of beauty products with other of the plurality of beauty products.” *Coleman* also fails to teach or suggest

the claimed “processing.” *Coleman* merely mentions identifying products by measuring user requirements and changes in those requirements. Contrary to the Examiner’s allegations (OA at 18), the disclosure of presenting users with feature selections and allowing users to view a generated product set does not teach or suggest “processing, using an artificial intelligence engine, information characterizing . . . selected beauty products and suitability of use information to thereby identify at least one additional product, complementary to a combination of . . . the selected products,” as recited in claim 21. Further, allowing users to compare products, as mentioned by *Coleman*, does not teach or suggest the claimed “processing.” Indeed, *Coleman* does not disclose the “processing” recited in claim 21.

Accordingly, neither *Lambertsen* nor *Coleman*, nor any combination thereof, teaches or suggests each and every feature of claim 21. As such, *prima facie* obviousness has not been established and the § 103(a) rejection of claim 21 should be withdrawn.

Moreover, *prima facie* obviousness has not been established at least because the requisite motivation to modify *Lambertsen* in view of *Coleman* is lacking. Determinations of obviousness must be supported by evidence on the record. See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (finding that the factual determinations central to the issue of patentability, including conclusions of obviousness by the Board, must be supported by “substantial evidence”). Further, the desire to combine references must be proved with “substantial evidence” that is a result of a “thorough and searching” factual inquiry. *In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52).

In this case, the Office Action does not show, by substantial evidence, that a skilled artisan considering *Lambertsen* and *Coleman*, and not having the benefit of Applicants’ disclosure, would have been motivated to combine or modify those references in a manner

resulting in Applicants' claimed combination. The Examiner alleged that a skilled artisan would have modified *Lambertsen* "for the purpose of guiding the user to personalized beauty advice" (OA at 19). This allegation in the Office Action is not properly supported and does not establish that a skilled artisan would have modified *Lambertsen* as alleged. Applicants call attention to M.P.E.P. § 2143.01, which makes clear that: "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" (citations omitted). The Office Action does not show that the cited art "suggests the desirability" of the alleged modification. Applicants submit that the conclusions in the Office Action were not reached based on facts gleaned from the cited references and that, instead, teachings of the present application were improperly used to reconstruct the prior art.

For at least the foregoing reasons, *prima facie* obviousness has not been established with respect to claim 21 and the rejection of that claim under 35 U.S.C. § 103(a) should be withdrawn. The § 103(a) rejection of claims 22 and 23 should be withdrawn as well, at least because those claims depend upon base claim 21. Applicants thus request withdrawal of the rejection of claims 21-23 under 35 U.S.C. § 103(a) and the timely allowance of those claims.

VIII. Rejection of claims 28-35, 70-79 and 81-86 under 35 U.S.C. § 103(a)

Applicants traverse the rejection of claims 28-35, 70-79 and 81-86 under 35 U.S.C. § 103(a) because a case for *prima facie* obviousness has not been established.

Claims 28-35 ultimately depend from base claim 24. *Coleman* does not teach or suggest each and every feature of claim 24 for the reasons explained above. *Coleman* therefore does not teach or suggest each and every element in dependent claims 28-35, each of which includes all of the elements of claim 24. In particular, *Coleman* does not teach or suggest the "accessing . . .

information about relationships” and “identifying” features recited in claim 24 and required by claims 28-35. In addition, with regard to claim 28, the Examiner concedes that *Coleman* fails to disclose that the at least one user-specified product is a cosmetic product and the at least one recommended complementary product is at least one of an apparel product and an accessory product.

Lambertsen fails to cure *Coleman*’s deficiencies. *Lambertsen* describes a virtual makeover system, which includes a product catalog, a palette database and an image database.

Lambertsen does not disclose at least:

accessing through the artificial intelligence search engine
information about relationships between at least some of the
plurality of products; [and]

identifying, by the artificial intelligence engine, at least one
recommended product complementary to the at least one user-
specified product using at least the information about product
relationships.

Although *Lambertsen*’s palettes include products that may be used for a makeover, *Lambertsen* does not disclose accessing information about relationships between at least some of a plurality of products as claimed. *Lambertsen* also fails to teach or suggest identifying at least one recommended product complementary to at least one user-specified product using at least the information about product relationships. *Lambertsen* merely discloses that the palettes are pre-configured or created by a user from a list of available products (page 3, ¶ 29). Accordingly, neither *Coleman* nor *Lambertsen*, nor any combination thereof, teaches or suggests each and every feature of claims 28-35. Because the applied references do not teach or suggest each and every feature of claims 28-35, the § 103(a) rejection of these claims should be withdrawn.

Further, with regard to claim 31, the applied references do not teach or suggest accessing through the artificial intelligence search engine information about relationships between at least

some of the plurality of products, “wherein the information about relationships is obtained by surveying at least one of consumer preferences and consumer habits,” as claimed. Contrary to the Examiner’s allegation (OA at 20-21), *Coleman*’s disclosure regarding users surveying different options to gather information about a product before requesting to view all of the identified products and classifying product selections (page 7, ¶ 59) does not teach or suggest accessing information about relationships between products, wherein the information is obtained by surveying at least one of consumer preferences and consumer habits. *Lambertsen* does not cure this deficiency in *Coleman*. For these additional reasons, the § 103(a) rejection of claim 31 should be withdrawn.

Moreover, *prima facie* obviousness has not been established with respect to claims 28-35 at least because the requisite motivation to modify *Coleman* in view of *Lambertsen* is lacking. The Office Action does not show, by substantial evidence, that a skilled artisan considering *Coleman* and *Lambertsen*, and not having the benefit of Applicants’ disclosure, would have been motivated to combine or modify those references in a manner resulting in Applicants’ claimed combination. The Examiner alleged that a skilled artisan would have modified *Lambertsen* “for the purpose of guiding the user to personalized beauty advice” (OA at 20). This allegation in the Office Action is not properly supported and does not establish that a skilled artisan would have modified *Coleman* as alleged. The Office Action does not show that the cited art “suggests the desirability” of the alleged modification. Applicants submit that the conclusions in the Office Action were not reached based on facts gleaned from the cited references and that, instead, teachings of the present application were improperly used to reconstruct the prior art.

For at least the foregoing reasons, *prima facie* obviousness has not been established with respect to claims 28-35 and the § 103 rejection of those claims should be withdrawn. Applicants therefore request withdrawal of the rejection and the timely allowance of those claims.

Independent claim 70, as currently presented, recites a combination including “selecting at least one second beauty product complementary to the first beauty product based on information reflecting a relationship between the first beauty product and the second beauty product.” For at least reasons similar to those presented above in connection with claim 24, *Coleman* fails to disclose this feature of claim 70. In addition, *Lambertsen* fails to cure *Coleman*’s deficiencies. Although *Lambertsen* discloses palettes of products that may be used together, *Lambertsen* does not disclose selecting at least one second beauty product complementary to a first beauty product based on information reflecting a relationship between the first beauty product and the second beauty product. Because neither *Coleman* nor *Lambertsen*, nor any combination thereof, teaches or suggests each and every feature of claim 70, the § 103(a) rejection should be withdrawn.

In addition, *prima facie* obviousness has not been established with respect to claim 70 at least because the requisite motivation to modify *Coleman* in view of *Lambertsen* is lacking. Again, the Examiner alleged that a skilled artisan would have modified *Lambertsen* “for the purpose of guiding the user to personalized beauty advice” (OA at 23). This allegation, however, does not establish that a skilled artisan would have performed the alleged modification. Further, applicants submit that the conclusions in the Office Action were not reached based on facts gleaned from the cited references and that, instead, teachings of the present application were improperly used to reconstruct the prior art. For at least these additional reasons, the rejection of claim 70 under 35 U.S.C. § 103(a) should be withdrawn.

Claims 71-79 and 81-86 depend (directly or indirectly) from claim 70. The rejection of claims 71-79 and 81-86 should be withdrawn at least because these claims depend from claim 70. Applicants thus request withdrawal of the rejection of claims 70-79 and 81-86 under 35 U.S.C. § 103(a) and the timely allowance of those claims.

IX. Rejection of claims 13, 42-44 and 47-51 under 35 U.S.C. § 103(a)

Applicants traverse the rejection of claims 13, 42-44 and 47-51 under 35 U.S.C. § 103(a) because a case for prima face obviousness has not been established.

Claim 13 depends from claim 1. *Dooley* does not teach or suggest each and every feature of dependent claim 13, which includes all of the features of claim 1. For example, *Dooley* does not teach or suggest at least the “accessing” and “identifying” recited in claim 1 and required by claim 13. Moreover, as affirmed by the Examiner (OA at 26) *Dooley* does not disclose that “the information reflecting relationships is derived by surveying at least one of consumer preferences and consumer habits,” as recited in claim 13.

Coleman does not cure *Dooley*’s deficiencies. *Coleman* does not disclose at least the “accessing” recited in claim 1 and required by claim 13. *Coleman* describes a FLE that can “evaluate . . . user requirements against available products or services to generate product or service recommendations most closely matching the user requirements” (page 6, ¶ 57). *Coleman* describes a database that stores products and product information (page 9, ¶ 82). According to *Coleman*, the database includes product criteria (e.g., size, etc.), questions associated with the criteria, options for the criteria, controls for selecting the options, selection guidance for the options, and links to other criteria (page 9, ¶ 82). This information does not constitute information reflecting relationships between categories of user-specific information and beauty advice, the information reflecting relationships derived from at least one of consumer

preferences and expert advice, as claimed. Indeed, *Coleman* does not disclose “accessing a data structure containing information reflecting relationships . . .” as claimed.

In addition, *Coleman* does not teach or suggest that “the information reflecting relationships is derived by surveying at least one of consumer preferences and consumer habits,” as recited in claim 13. Contrary to the Examiner’s allegations (OA at 26), *Coleman*’s disclosure regarding users surveying different options to gather information about a product before requesting to view all of the identified products and classifying product selections (page 7, ¶ 59) does not teach or suggest that data reflecting relationships between categories of user-specific information and beauty advice is derived by surveying at least one of consumer preferences and consumer habits, as claimed.

Accordingly, neither *Dooley* nor *Coleman*, nor any combination thereof, teaches or suggests each and every feature required by claim 13. Because the applied references do not teach or suggest each and every claimed feature, the § 103(a) rejection of claim 13 should be withdrawn.

Furthermore, *prima facie* obviousness has not been established with respect to claim 13 because the required motivation for modifying *Dooley* in view of *Coleman* is lacking. The Examiner has not shown that a skilled artisan considering *Dooley* and *Coleman*, and not having the benefit of Applicants’ disclosure, would have been motivated to modify *Dooley* in a manner resulting in Applicants’ claimed combination. The Examiner alleges that a skilled artisan would have modified *Dooley* in view of *Coleman* “for the purpose of inexpensively guiding the user to personalized beauty advice” (OA at 26). This allegation is not properly supported and does not establish that a skilled artisan would have modified *Dooley* as alleged. Moreover, the Office Action does not show that the cited art “suggests the desirability” of the alleged modification.

For example, the Examiner points to no mention in either of the references regarding “inexpensively guiding the user.” Further, the Examiner provides no evidence or reasoning to show how the alleged modification would in fact inexpensively guide a user to personalized beauty advice, or to show that a skilled artisan, considering *Dooley*’s system, would even be concerned with reducing expense. The Examiner also fails to articulate what expenses are being considered. In attempting to establish a motivation, the Examiner notes *Coleman*’s disclosure of “[p]roviding . . . guidance to the user” and *Dooley*’s disclosure of “increasing traffic at the lowest per visitor cost” (OA at 26). These disclosures do not establish that a skilled artisan would have modified *Dooley* as alleged. That is, the noted disclosures do not teach or suggest that modifying *Dooley*’s system as alleged would inexpensively guide users. The Office Action does not show the alleged motivation to be present in the relied-upon art or in the knowledge generally available to one skilled in the art. Applicants submit that the conclusions of obviousness in the Office Action were not reached based on facts gleaned from the cited references and that, instead, Applicants’ claims were improperly used to reconstruct the prior art. For these additional reasons, the § 103(a) rejection of claim 13 should be withdrawn. Applicants thus request withdrawal of the rejection and the timely allowance of claim 13.

Each of claims 42-44 and 47-51 depends (directly or indirectly) from base claim 36. *Dooley* does not teach or suggest each and every feature of dependent claims 42-44 and 47-51, each of which includes all of the features of claim 36. For example, for the reasons presented above, *Dooley* fails to teach or suggest “a data structure containing information reflecting relationships between categories of user-specific information and beauty advice, the information reflecting relations derived from at least one of consumer preferences and expert advice,” as claimed. *Dooley* further fails to teach or suggest the claimed “artificial intelligence engine.”

Coleman does not cure *Dooley*'s deficiencies. For reasons similar to those noted above in connection with claim 13, *Coleman* does not teach or suggest "a data structure containing information reflecting relationships between categories of user-specific information and beauty advice, the information reflecting relations derived from at least one of consumer preferences and expert advice," as recited in claim 36 and required by each of claims 42-44 and 47-51.

In addition, for reasons similar to those presented above in connection with claim 13, the cited art fails to teach or suggest that "the information reflecting relationships is derived by surveying at least one of consumer preferences and consumer habits," as required by dependent claim 48. Accordingly, neither *Dooley* nor *Coleman*, nor any combination thereof, teaches or suggests each and every feature required by claims 42-44 and 47-51. The § 103(a) rejection of these claims should be withdrawn.

Further, *prima facie* obviousness has not been established with respect to claims 42-44 and 47-51 because the requisite motivation for modifying *Dooley* in view of *Coleman* is lacking. Again, the Examiner alleged that a skilled artisan would have modified *Dooley* in view of *Coleman* "for the purpose of inexpensively guiding the user to personalized beauty advice" (OA at 28 and 29). For reasons similar to those presented above in connection with claim 13, the required motivation has not been established with respect to claims 42-44 and 47-51. For these additional reasons, the § 103(a) rejection of claims 42-44 and 47-51 should be withdrawn. Applicants thus request withdrawal of the rejection and the timely allowance of these claims.

X. Rejection of claims 45 and 46 under 35 U.S.C. § 103(a)

Applicants traverse the rejection of claims 45 and 46 under 35 U.S.C. § 103(a) because a case for *prima facie* obviousness has not been established.

Claims 45 and 46 ultimately depend from claim 36. As explained above in connection with claims 42-44 and 47-51, neither *Dooley* nor *Coleman* teaches or suggests each and every feature of claim 36. These references therefore fail to teach or suggest each and every feature of claims 45 and 46, each of which includes all of the features of claim 36.

Lambertsen fails to cure the deficiencies of *Dooley* and *Coleman*. *Lambertsen* describes a virtual makeover system. *Lambertsen* fails to teach or suggest at least “a data structure containing information reflecting relationships between categories of user-specific information and beauty advice, the information reflecting relationships derived from at least one of consumer preferences and expert advice,” which is missing from *Dooley* and *Coleman* but recited in claim 36 and required by both claims 45 and 46. Accordingly, neither *Dooley*, *Coleman* nor *Lambertsen*, nor any combination thereof, teaches or suggests each and every element recited in claims 45 and 46. As such, *prima facie* obviousness has not been established and the rejection of claims 45 and 46 under 35 U.S.C. § 103(a) should be withdrawn.

Further, the requisite motivation for modifying *Dooley* in view of *Coleman* and *Lambertsen* is lacking. The Examiner alleged that a skilled artisan would have modified *Dooley* in view of *Coleman* and *Lambertsen* “for the purpose of inexpensively guiding the user to personalized beauty advice” (OA at 32). The required motivation has not been established for reasons similar to those presented above in connection with claims 13, 42-44 and 47-51. For this additional reason, the rejection of claims 45 and 46 under 35 U.S.C. § 103(a) should be

withdrawn. Applicants thus request withdrawal of the § 103(a) rejection of claims 45 and 46 and the timely allowance of these claims.

XI. Rejection of claims 17-19 and 52-54 under 35 U.S.C. § 103(a)

Applicants traverse the rejection of claims 17-19 and 52-54 under 35 U.S.C. § 103(a) because a case for *prima facie* obviousness has not been established.

Claims 17-19 depend from claim 1. For the reasons presented above, *Dooley* does not teach or suggest each and every feature of claim 1. *Dooley* therefore fails to teach or suggest each and every feature of claims 17-19, each of which includes all of the features of claim 1.

Lambertsen fails to cure the deficiencies of *Dooley*. *Lambertsen*, which is directed to a virtual makeover system, does not teach or suggest at least the “accessing” and “identifying” required by dependent claims 17-19 but missing from *Dooley*. Accordingly, neither *Dooley* nor *Lambertsen*, nor any combination thereof, teaches or suggest each and every feature recited in claim 1 and required by each of claims 17-19.

Further, with regard to claim 17, neither *Dooley* nor *Lambertsen* teaches or suggests that “the accessed data structure includes information characterizing a plurality of beauty products and information about suitability of combining at least some of the plurality of beauty products with other of the plurality of beauty products,” as claimed. The Examiner notes *Lambertsen*’s disclosure of a product catalog and palette database (page 1, ¶ 8). Contrary to the Examiner’s position, however, a catalog of a variety of beauty products does not teach or suggest information characterizing a plurality of beauty products and information about suitability of combining products. Further, a palette of beauty products that create a makeover does not teach or suggest information characterizing a plurality of beauty products and information about suitability of combining products. Although *Lambertsen*’s palettes include products that may be

combined, *Lambertsen* does not disclose accessing a data structure that includes information characterizing beauty products and information about suitability of combining beauty products. As noted above, *Lambertsen* merely discloses that the palettes are pre-configured or created by a user from a list of available products (page 3, ¶ 29).

In addition, with regard to claim 19, neither *Dooley* nor *Lambertsen* teaches or suggests that “information characterizing a plurality of beauty products includes information about inter-product compatibility,” as claimed. Because the applied references, taken alone or in combination, do not teach or suggest each and every claimed element, *prima facie* obviousness has not been established and the rejection of claims 17-19 under 35 U.S.C. § 103(a) should be withdrawn.

Moreover, *prima facie* obviousness has not been established with respect to claims 17-19 at least because the requisite motivation for modifying *Dooley* in view of *Lambertsen* is lacking. The Examiner has not shown that a skilled artisan considering *Dooley* and *Lambertsen*, and not having the benefit of Applicants’ disclosure, would have been motivated to modify *Dooley* in a manner resulting in Applicants’ claimed combination. The Examiner alleged that a skilled artisan would have modified *Dooley* in view of *Lambertsen* “for the purpose of inexpensively guiding the user to personalized beauty advice” (OA at 34). This allegation is not properly supported and does not establish that a skilled artisan would have modified *Dooley* as alleged. For example, the Examiner points to no mention in either of the references regarding “inexpensively guiding the user.” The Office Action does not show the alleged motivation to be present in the relied-upon art or in the knowledge generally available to one skilled in the art. Again, the conclusions of obviousness in the Office Action were not reached based on facts gleaned from the cited references and that, instead, Applicants’ claims were improperly used to

reconstruct the prior art. For at least these additional reasons, *prima facie* obviousness has not been established and the rejection of claims 17-19 under 35 U.S.C. 103(a) should be withdrawn. Applicants thus request withdrawal of the § 103(a) rejection of claims 17-19 and the timely allowance of those claims.

Claims 52-54 depend from base claim 36. As explained above, *Dooley* does not teach or suggest each and every feature of claim 36. *Dooley* therefore fails to teach or suggest each and every feature of claims 52-54, each of which includes all of the features of claim 36.

Lambertsen fails to cure the deficiencies of *Dooley*. *Lambertsen* does not teach or suggest at least the “data structure” and “artificial intelligence engine,” which are missing from *Dooley* but recited in claim 36 and required by each of claims 52-54.

Further, for reasons similar to those presented above in connection with claim 17, neither *Dooley* nor *Lambertsen* teaches or suggests that “the data structure includes information characterizing a plurality of beauty products and information about suitability of combining at least some of the plurality of beauty products with other of the plurality of beauty products,” as recited in claim 52. For the reasons noted above in connection with claim 19, *Dooley* and *Lambertsen* also fail to teach or suggest that “information characterizing a plurality of beauty products includes information about inter-product compatibility,” as recited in claim 54. Accordingly, the applied references, taken alone or in combination, do not teach or suggest each and every element recited in claims 52-54 and the § 103(a) rejection should therefore be withdrawn.

The requisite motivation for modifying *Dooley* in view of *Lambertsen* is also lacking. The Examiner alleged that a skilled artisan would have modified *Dooley* in view of *Lambertsen* “for the purpose of inexpensively accentuating user features” (OA at 35). This allegation is not

properly supported and does not establish that a skilled artisan would have modified *Dooley* as alleged. For example, the Examiner points to no mention in either of the references regarding “inexpensively accentuating user features.” Further, the Examiner provides no evidence or reasoning to show how the alleged modification would in fact inexpensively accentuate user features, or to show that a skilled artisan would even be concerned with reducing expenses associated with accentuating user features. The Examiner also fails to articulate what expenses would be involved. In attempting to establish a motivation, the Examiner notes *Dooley*’s disclosure of “increasing traffic at the lowest per visitor cost” and *Lambertsen*’s disclosure of “[a]ccentuating . . . user’s features” (OA at 35). These disclosures do not establish that a skilled artisan would have modified *Dooley* as alleged. That is, the noted disclosures do not teach or suggest that modifying *Dooley*’s system as alleged would facilitate inexpensively accentuating user features. The Office Action does not show the alleged motivation to be present in the relied-upon art or in the knowledge generally available to one skilled in the art. Again, the conclusions of obviousness in the Office Action were not reached based on facts gleaned from the cited references and, instead, Applicants’ claims were improperly used to reconstruct the prior art. For these additional reasons, the § 103(a) rejection of claims 52-54 should be withdrawn. Applicants thus request withdrawal of the § 103(a) rejection of claims 52-54 and the timely allowance of those claims.

XII. Rejection of claims 20 and 55 under 35 U.S.C. § 103(a)

Applicants traverse the rejection of claims 20 and 55 under 35 U.S.C. § 103(a) for at least the following reasons.

Claim 20 depends from claim 17, which in turn depends from claim 1. *Dooley* and *Lambertsen* fail to teach or suggest each and every feature of claim 20, which includes all of the

features of claims 1 and 17. As explained above in connection with claim 17, neither *Dooley* nor *Lambertsen* teaches or suggests at least the “accessing” and “identifying” recited in claim 1. In addition, as noted above, neither *Dooley* nor *Lambertsen* teaches or suggests that “the accessed data structure includes information characterizing a plurality of beauty products and information about suitability of combining at least some of the plurality of beauty products with other of the plurality of beauty products,” as recited in claim 17.

Coleman fails to cure the deficiencies of *Dooley* and *Lambertsen*. For example, as noted above (see, e.g., claim 13), *Coleman* does not disclose the claimed “accessing.” In addition, *Coleman* does not disclose the elements added by dependent claims 17 and 20. Because the applied references, taken alone or in combination, do not teach or suggest each and every element recited in claim 20, the § 103(a) rejection should be withdrawn. In addition, the § 103(a) rejection should be withdrawn because the requisite motivation for modifying *Dooley* in view of *Lambertsen* and *Coleman* is lacking. The allegations relating to motivation in the Office Action are not properly supported and do not establish that a skilled artisan would have modified *Dooley* as alleged. For at least these reasons, Applicants request withdrawal of the rejection of claim 20 under 35 U.S.C. § 103(a) and the timely allowance of that claim.

Claim 55 depends from claim 52, which in turn depends from claim 36. As explained above in connection with claim 52, neither *Dooley* nor *Lambertsen* teaches or suggests at least the “data structure” and “artificial intelligence engine” recited in claim 36. In addition, as noted above, neither *Dooley* nor *Lambertsen* teaches or suggests that “the data structure includes information characterizing a plurality of beauty products and information about suitability of combining at least some of the plurality of beauty products with other of the plurality of beauty

products,” as recited in claim 52. *Dooley* and *Lambertsen* therefore fail to teach or suggest each and every feature of claim 55, which includes all of the features of claims 36 and 52.

Coleman fails to cure the deficiencies of *Dooley* and *Lambertsen*. For example, (for reasons similar to those presented above in connection with claims 13) *Coleman* does not disclose the claimed “data structure.” *Coleman* also appears to lack disclosure of the elements added by dependent claims 52 and 55. Accordingly, the applied references, taken alone or in combination, do not teach or suggest each and every element recited in claim 55 and, thus, the rejection of that claim under 35 U.S.C. § 103(a) should be withdrawn. In addition, the § 103(a) rejection should be withdrawn because the requisite motivation for modifying *Dooley* in view of *Lambertsen* and *Coleman* is lacking. The allegations relating to motivation in the Office Action are not properly supported and do not establish that a skilled artisan would have modified *Dooley* as alleged. For at least these reasons, Applicants request withdrawal of the rejection of claim 55 under 35 U.S.C. § 103(a) and the timely allowance of that claim.

XIII. Rejection of claim 60 under 35 U.S.C. § 103(a)

Applicants traverse the rejection of claim 60 under 35 U.S.C. § 103(a) for at least the following reasons.

Claim 60 depends upon claim 56. As explained above, *Coleman* fails to teach or suggest at least the following features of claim 56:

at least one location for storing information about suitability of
using at least one of the plurality of products with at least one other
of the plurality of products . . . and

an artificial intelligence engine configured to process information
reflective of the at least one user-selected product, at least some of
the characterizing information, at least some of the suitability
information, and at least some of the personal information, and to
identify therefrom at least one product complementary to the at
least one user-selected product.

Coleman therefore fails to teach or suggest each and every feature of claim 60, which includes all of the features of claim 56.

Dooley fails to cure *Coleman*'s deficiencies. *Dooley*, which describes an Internet-based information network, does not disclose or suggest the claimed "location for storing information about suitability" or the claimed "artificial intelligence engine." Accordingly, neither *Coleman* nor *Dooley*, nor any combination thereof, teaches or suggests each and every element recited in claim 56 and required by claim 60. For at least this reason, the rejection of claim 60 under 35 U.S.C. § 103(a) should be withdrawn.

Furthermore, the § 103(a) rejection of claim 60 should be withdrawn at least because the requisite motivation for modifying *Coleman* in view of *Dooley* is lacking. The Examiner alleged that a skilled artisan would have modified *Dooley* in view of *Lambertsen* "for the purpose of inexpensively guiding the user to personalized beauty advice" (OA at 41). This allegation in the Office Action is not properly supported and does not establish that a skilled artisan would have modified *Dooley* as alleged (see e.g., arguments for claim 13). The Office Action does not show the alleged motivation to be present in the relied-upon art or in the knowledge generally available to one skilled in the art. Applicants submit that the conclusions of obviousness in the Office Action were not reached based on facts gleaned from the cited references and that, instead, Applicants' claims were improperly used to reconstruct the prior art. For these additional reasons, the rejection of claim 60 under 35 U.S.C. § 103(a) should be withdrawn. Applicants thus request withdrawal of the § 103(a) rejection of claim 60 and the timely allowance of that claim.

XIV. Rejection of claim 80 under 35 U.S.C. § 103(a)

Applicants traverse the rejection of claim 80 under 35 U.S.C. § 103(a) for at least the following reasons.

Claim 80 depends upon claim 70. For the reasons noted above, neither *Coleman* nor *Lambertsen*, nor any combination thereof, teaches or suggests “selecting at least one second beauty product complementary to the first beauty product based on information reflecting a relationship between the first beauty product and the second beauty product,” as recited in claim 70. *Coleman* and *Lambertsen* therefore fail to teach or suggest each and every feature of claim 80, which includes all of the features of claim 70.

Horikita does not cure the deficiencies of *Coleman* and *Lambertsen*. *Horikita* is directed to a make-up simulator. *Horikita* does not teach or suggest at least “selecting at least one second beauty product complementary to the first beauty product based on information reflecting a relationship between the first beauty product and the second beauty product,” as claimed.

Marapane does not cure the deficiencies of *Coleman*, *Lambertsen* and *Horikita*. *Marapane* describes a system for analyzing hair. *Marapane* discloses predicting achievable hair colors for users and recommending color agents based on those achievable colors selected by the users (Figs. 1, 12; col. 3, line 9 – col. 4, line 45). Although *Marapane* mentions product recommendations, it does not teach or suggest “selecting at least one second beauty product complementary to the first beauty product based on information reflecting a relationship between the first beauty product and the second beauty product,” as claimed. Accordingly, neither *Coleman*, *Lambertsen*, *Horikita* nor *Marapane*, nor any combination thereof, teaches or suggests the “selecting” recited in claim 70 and required by dependent claim 80. Because the applied

references, taken alone or in combination, do not teach or suggest each and every element required by claim 80, the rejection of that claim under 35 U.S.C. § 103(a) should be withdrawn.

In addition, the § 103(a) rejection of claim 80 should be withdrawn at least because the requisite motivation for modifying *Coleman* in view of *Lambertsen*, *Horikita* and *Marapane* is lacking. The Examiner alleged that a skilled artisan would have modified *Coleman* “for the purpose of efficiently guiding the user to personalized beauty advice” (OA at 44). This allegation in the Office Action is not properly supported and does not establish that a skilled artisan would have modified *Coleman* as alleged. For example, the Examiner points to no mention in either of the references regarding “efficiently guiding the user.” Further, the Examiner provides no evidence or reasoning to show how the alleged modification would in fact achieve the alleged result, or show that a skilled artisan would even be concerned with achieving that result. The Examiner also fails to articulate a basis for evaluating efficiency. In attempting to establish a motivation, the Examiner notes *Coleman*’s alleged disclosure of “[p]roviding valuable guidance” and *Lambertsen*’s disclosure of “[a]ccentuating . . . user’s features” (OA at 43). The Examiner also notes *Horikita*’s alleged disclosure of “[i]mproved operability and processing” and *Marapane*’s disclosure of “[a]ccounting for lighting difference.” These disclosures do not establish that a skilled artisan would have modified *Coleman* as alleged. That is, the noted disclosures do not teach or suggest modifying *Coleman*’s system to efficiently guide users. The fact that the references might mention guidance and improved operability does not establish that a skilled artisan would have combined the references as alleged. The Office Action does not show the alleged motivation to be present in the relied-upon art or in the knowledge generally available to one skilled in the art. Again, the conclusions of obviousness in the Office Action were not reached based on facts gleaned from the cited references and, instead,

Applicants' claims were improperly used to reconstruct the prior art. For these additional reasons, the rejection of claim 80 under 35 U.S.C. § 103(a) should be withdrawn. Applicants thus request withdrawal of the § 103(a) rejection of claim 80 and the timely allowance of that claim.

XV. Conclusion


The claimed invention is neither anticipated nor rendered obvious in view of the references cited against this application. Applicants request the Examiner's reconsideration of the application in view of the foregoing, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 6, 2004

By: 
Frank A. Italiano
Reg. No. 53,056